

REMARKS

The present Amendment is responsive to the Final Office Action mailed March 19, 2003 in the above-identified patent application. Enclosed herewith is a Petition requesting a three-month extension of time for resetting the deadline for responding to the Final Office Action from June 19, 2003, to and including September 19, 2003.

The Examiner rejected claims 19-26 under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner asserted that in claim 19, at line 10, the recitation "said controller" lacks antecedent basis. In response, claim 19 has been amended to change "said controller" to --a controller--.

The Examiner rejected claims 1-12 and 15-26 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,140,614 to Padamsee in view of U.S. Patent 5,843,353 to Lin and U.S. Patent 5,678,925 to Garmaise et al. Referring to FIG. 1 thereof, Padamsee discloses an electric drinking cup including a plastic inner liner, a metal outer shell, an insulation-filled space in between and a heating element electrically connectable with a vehicle's electrical system. Referring to FIGS. 1 and 2 thereof, Lin discloses a heatable cup 10 insertable into a base 14 for heating or cooling a liquid in the cup. The base 14 has a power switch 20 for activating the apparatus 8, a temperature display 22 for displaying the temperature of the liquid 11 sensed by the sensor 38 and a temperature setting means 18 for setting a target temperature. The base includes a recess 25 for receiving a lower end of container 10. Referring to FIG. 1 thereof, Garmaise discloses a hot beverage mug 10 including a handle 11, aural means 12 and visual means 13 for indicating the temperature of a beverage 50 held by the mug 10. Referring to FIG. 1, the mug 10 also includes an on/off switch 18a. The Examiner asserts that it would have been obvious to adapt the control enhancements suggested by Lin to the mug of Padamsee to improve temperature control and to integrally attach the control

into the side of the mug as disclosed in Garmaise for the sake of more convenient monitoring and control by the user.

Applicants respectfully assert that the claims of the present application are unobvious because the mere fact that they can be combined or modified does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. 2143.01 citing *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Clearly, the references provided by the Examiner provide no suggestion that the references be combined to meet the limitations set forth in independent claims 1, 19 and 27.

Applicants also respectfully note that the modification proposed by the Examiner cannot change the principal of operation of a reference. As set forth in the M.P.E.P., "if the proposed modification or combination of the prior art would change the principal of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." M.P.E.P. 2143.01 Specifically, column 1, lines 31-35 of Lin teach "an apparatus which comprises a base and a portable container which can be detached from the base when drinking and attached back to the base for heating or cooling the drink loaded inside the container." To modify Lin as suggested by the Examiner, (i.e., permanently attach the base to the portable container) would clearly change the principal of operation of the reference. This is clearly prohibited by the M.P.E.P. Moreover, Lin's principal of operation actually teaches away from the claims of the present application. As such, it is impermissible to add Lin to Padamsee and Garmaise. For all of these reasons, Applicants respectfully assert that claims 1-6, 8-11 and 16-25 are allowable.

wrong

assertion w/o grounds

The Examiner also rejected claims 13 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Padamsee in view of Lin and Garmaise and further in view of U.S. Patent 5,042,248 to Sundhar. Referring to FIG. 2 thereof, the Examiner asserts that

Sundhar discloses a removable mug liner. In response, Applicants respectfully assert that Sundhar does not overcome the deficiencies noted in Padamsee, Lin and Garmaise. Applicants also note that claim 14 has been cancelled.

Applicants have also added new claims 27-31 that are fully supported by the originally filed specification and add no new matter. New claims 27-31 are allowable for the reasons set forth above.

On September 12, 2003, the undersigned contacted the Examiner to request a personal interview on the application after the Request for Continued Examination and the present Amendment have been received at the United States Patent and Trademark Office. Applicants acknowledge and appreciate the Examiner's indication that he will contact the undersigned Attorney to schedule the above-mentioned personal interview. The undersigned will await contact from the Examiner regarding the personal interview.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: September 12, 2003

Respectfully submitted,

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